

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ROTHSCHILD DIGITAL
CONFIRMATION, LLC,

Plaintiff,

V.

COMPANYCAM, INC.,

Defendant.

Redacted- Public Version

C.A. No. 19-1109-MN

**DECLARATION OF RACHAEL D. LAMKIN IN SUPPORT
OF COMPANYCAM'S SECTION 285 MOTION**

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Karen E. Keller (No. 4489)
Andrew E. Russell (No. 5382)
Nathan R. Hoeschen (No. 6232)
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Dated: April 16, 2020

I, Rachael D. Lamkin, declare as follows:

1. I am lead counsel of record for Defendant CompanyCam. I am an attorney licensed to practice law in all state and federal courts in California, the Eastern District of Texas, Colorado federal court, the Court of International Trade, the International Trade Commission, and the Federal Circuit Court of Appeals. I was admitted *Pro Hac Vice* in this matter on August 29, 2019.

2. I am over the age of 18, and I have personal knowledge of the facts set forth herein and could competently testify about these matters if called upon to do so.

3. The patent litigation analytics company, RPX, reports that Rothschild has filed 820 patent litigations in the United States. See <https://insight.rpxcorp.com/ent/352299-leigh-m-rothschild>. 747 of those cases are no longer active, 73 of them are active.

4. RPX also reports that Leigh Rothschild is consistently among the most prolific patent assertion entities year after year.

- a. See <https://www.rpxcorp.com/wp-content/uploads/sites/2/2017/05/the-most-active-patent-trolls-of-2016.pdf>
- b. <https://www.csmonitor.com/Technology/2016/0106/Despite-crackdown-from-courts-patent-suits-still-battered-tech-companies-in-2015>

5. The courts as well as the patent and intellectual property press consistently identify Rothschild as someone that files meritless claims. See, e.g.:

- a. *Rothschild Connected Devices Innovations, LLC v. Guardian Prot. Servs.*, 858 F.3d 1383, 1390 (Fed. Cir. 2017).
- b. <https://www.eff.org/deeplinks/2017/06/federal-circuit-hits-stupid-patent-owner-fee-award>

- c. <https://arstechnica.com/tech-policy/2017/04/garmin-sued-in-east-texas-over-patents-on-an-internet-drink-mixer-seeks-legal-fees/>

6. I ran a search for all patentee favorable outcomes for Rothschild's suits on Docket Navigator. Attached as Exhibit A is a true and correct copy of the results of that search. Of the hundreds of outcomes listed in the results, only 3 are listed as patentee favorable. I drilled down on those 3, and each of them did not actually favor the patentee.

- a. *Gameloft* was dismissed for failure to prosecute;
- b. *Coresystems* was dismissed without prejudice before claim construction;
- c. The *Mitek* case is the same patent as the case at bar. It ended in IPR with the asserted '872 claims being invalidated except for a couple of claims ultimately found to be patent ineligible here.

7. Using again the Docket Navigator database, I entered the '872 Patent into that database. The only claim constructions for the '872 Patent were for the aforementioned IPR; the claims of the '872 have never made it even as far as claim construction in district court.

8. Based on my firm's invoices, I estimate my firm will bill approximately 72 hours at \$500/hr.

9. Attached as Exhibit B is a chart I created mapping the "conventional" admissions in the '872 Patent to the asserted claim language.

10. Attached as Exhibits C and D are true and correct copies of RDC's settlement agreements with TerraGo and Field Agent, received by CompanyCam upon service of a Rule 45 subpoena.

11. [REDACTED]

[REDACTED]

12. Attached as Exhibit E is a true and correct copy of the IPR decision for the '872 Patent.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Dated: April 16, 2020

/s/ Rachael D. Lamkin
Rachael D. Lamkin

CERTIFICATE OF SERVICE

I, Andrew E. Russell, hereby certify that on April 16, 2020, this document was served on the persons listed below in the manner indicated:

BY EMAIL

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Exhibit A



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Multiple Parties

Patentee Accusations & Outcomes

Patentees

13 Parties

Exported results are limited to 300. To view more data, open this search tab [in a browser](#).

Patentee	Patent ▲	Patent Challenger	Outcome
Rothschild Digital Media Innovations, LLC	6101534	G5 Entertainment AB	Settled/Voluntarily Dismissed
Rothschild Digital Media Innovations, LLC	6101534	Gameloft, SA	Patent Challenger Won (Related Case)
Rothschild Digital Media Innovations, LLC	6101534	Gameloft, SA	Patentee Won
Rothschild Digital Media Innovations, LLC	6101534	Sony Computer Entertainment America LLC	Patent Challenger Won
Rothschild Digital Media Innovations, LLC	6101534	Sony Computer Entertainment America LLC	Transferred
Rothschild Digital Media Innovations, LLC	6101534	Sony Computer Entertainment America LLC	Settled/Voluntarily Dismissed
Rothschild Digital Media Innovations, LLC	6101534	Supercell Oy	Patent Challenger Won (Related Case)
Rothschild Trust Holdings, LLC	6101534	Citrix Online, LLC	Settled/Voluntarily Dismissed
Rothschild Trust Holdings, LLC	6101534	Citrix Systems, Inc.	Settled/Voluntarily Dismissed
Rothschild Trust Holdings, LLC	6101534	ORB Networks, INC.	
Rothschild Trust Holdings, LLC	6101534	ORB Networks, INC.	
Rothschild Mobile Imaging Innovations, LLC	7450163	Bank of America Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Bank of America, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Citibank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Citigroup, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Fiserv, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	JPMorgan Chase Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	JPMorgan Chase & Co.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Mitek Systems, Inc.	Patent Challenger Won
Rothschild Mobile Imaging Innovations, LLC	7450163	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Wells Fargo Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7450163	Wells Fargo & Company	Patent Challenger Won (Related Case)

Rothschild Digital Confirmation, LLC	7456872	Abaqus Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Acumatica, Inc.	
Rothschild Digital Confirmation, LLC	7456872	Appsheet, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	BlueFolder Software, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Canvas Solutions, Inc. d/b/a GoCanvas	Transferred
Rothschild Digital Confirmation, LLC	7456872	Canvas Solutions, Inc. d/b/a GoCanvas	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Cellco Partnership d/b/a Verizon Wireless	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	ClickSoftware Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	CompanyCam, Inc.	
Rothschild Digital Confirmation, LLC	7456872	Coresystems AG	Patentee Won (Related Case)
Rothschild Digital Confirmation, LLC	7456872	dESCO LLC	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Epay Systems, Inc.	
Rothschild Digital Confirmation, LLC	7456872	Field Agent, Inc.	Patent Challenger Won (Related Case)
Rothschild Digital Confirmation, LLC	7456872	FieldAware US, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	FieldOne Systems LLC	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Fingent Corporation	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	FleetMatics USA Group Holdings, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	FleetMatics USA Holdings, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Fleetmatics USA, LLC	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Freshworks Inc. d/b/a Freshworks Enterprise, Inc.	
Rothschild Digital Confirmation, LLC	7456872	GoSpotCheck, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	IFS Americas, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Innovapptive, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Intuit Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Kickserv, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	mHelpDesk, Inc.	Patent Challenger Won (Related Case)
Rothschild Digital Confirmation, LLC	7456872	Mize, Inc.	
Rothschild Digital Confirmation, LLC	7456872	Oracle America, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Oracle America, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Replicon Software, Inc.	
Rothschild Digital Confirmation, LLC	7456872	Repsly, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Servicechannel.com, Inc.	
Rothschild Digital Confirmation, LLC	7456872	ServiceMax, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	ServicePower Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	simPRO Software Limited d/b/a simPRO United States	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Skedulo Holdings Inc.	
Rothschild Digital Confirmation, LLC	7456872	Synchroteam	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	TeamConnect, LLC	
Rothschild Digital Confirmation, LLC	7456872	Telogis, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	TerraGo Technologies, Inc.	Patent Challenger Won (Related Case)
Rothschild Digital Confirmation, LLC	7456872	Tsheets.com, Inc.	Settled/Voluntarily Dismissed
Rothschild Digital Confirmation, LLC	7456872	Wolf Mobile, Inc. d/b/a Ecomz Wireless	Patent Challenger Won (Related Case)

Rothschild Digital Confirmation, LLC	7456872	WorkWave LLC	Settled/Voluntarily Dismissed
Rothschild Mobile Imaging Innovations, LLC	7456872	Bank of America Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Bank of America, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Citibank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Citigroup, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Fiserv, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	JPMorgan Chase Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	JPMorgan Chase & Co.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Mitek Systems, Inc.	Patent Challenger Won
Rothschild Mobile Imaging Innovations, LLC	7456872	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Wells Fargo Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7456872	Wells Fargo & Company	Patent Challenger Won (Related Case)
Rothschild Connected Devices Innovations, LLC	7899713	Exxon Mobil Corporation	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	7899713	Garmin International, Inc.	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	7899713	GoPro, Inc.	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	7899713	LG Electronics, Inc.	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	7899713	LG Electronics USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	7899713	Motorola Mobility LLC	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	7899713	Whirlpool Corporation	Settled/Voluntarily Dismissed
Rothschild GPS Sharing Innovations, LLC	7917285	Nissan North America, Inc.	
Rothschild Location Technologies LLC	7917285	American Honda Motor Co., Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	CalAmp Corp.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Discrete Wireless, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Global Tracking Communications, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Glympse Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Hyundai Motor America	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Lyft, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Motorola Solutions, Inc. f/k/a Motorola, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Nissan North America, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Teletrac Inc.	
Rothschild Location Technologies LLC	7917285	Uber Technologies, Inc.	Settled/Voluntarily Dismissed

Rothschild Location Technologies LLC	7917285	Volkswagen Group of America, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Volkswagen Group of America, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	7917285	Volvo Cars of North America, LLC	Settled/Voluntarily Dismissed
Rothschild Mobile Imaging Innovations, LLC	7991792	Bank of America Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Bank of America, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Citibank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Citigroup, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Fiserv, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	JPMorgan Chase Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	JPMorgan Chase & Co.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Mitek Systems, Inc.	Patent Challenger Won
Rothschild Mobile Imaging Innovations, LLC	7991792	Mitek Systems, Inc.	Patentee Won
Rothschild Mobile Imaging Innovations, LLC	7991792	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Wells Fargo Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7991792	Wells Fargo & Company	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Bank of America Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Bank of America, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Citibank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Citigroup, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Fiserv, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	JPMorgan Chase Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	JPMorgan Chase & Co.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Mitek Systems, Inc.	Patent Challenger Won
Rothschild Mobile Imaging Innovations, LLC	7995118	Mitek Systems, Inc.	Patent Challenger Won (Related Case)

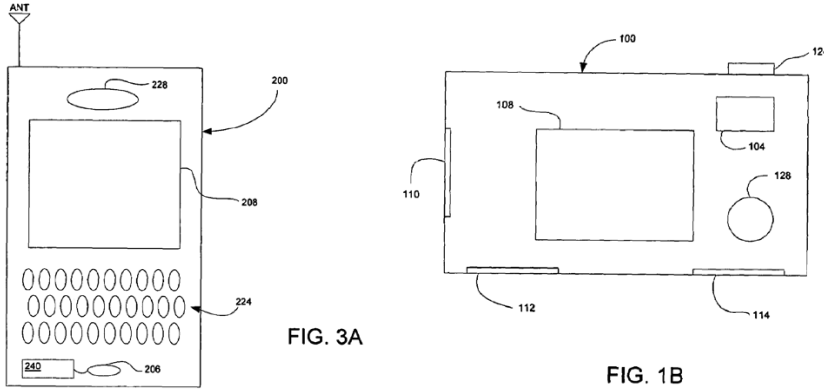
Rothschild Mobile Imaging Innovations, LLC	7995118	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Mitek Systems, Inc.	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	NCR Corporation	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Wells Fargo Bank, NA	Patent Challenger Won (Related Case)
Rothschild Mobile Imaging Innovations, LLC	7995118	Wells Fargo & Company	Patent Challenger Won (Related Case)
Rothschild Trust Holdings, LLC	7995118	Mitek Systems, Inc.	Patent Challenger Won
Rothschild Patent Imaging LLC	8204437	3D Robotics, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	ADT, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	ArcSoft, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Autel Robotics USA LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	D-Link Systems, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Edimax Computer Company	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	FLIR Lorex, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Honeywell International, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Horizon Hobby, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Logitech Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Lorex By FLIR f/k/a Lorex Technology, Inc.	Substituted
Rothschild Patent Imaging LLC	8204437	LT Security Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Netgear, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	On-Net Surveillance Systems, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Parrot, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Piximity, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Slomin's, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Swann Communications USA Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Swann Communications USA Inc.	Transferred
Rothschild Patent Imaging LLC	8204437	The Firelands Group, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Trendnet, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Vivint, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Vivotek USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	YI Technologies, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8204437	Yuneec USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Connected Devices Innovations, LLC	8417377	The Coca-Cola Company	Patent Challenger Won
Rothschild Connected Devices Innovations, LLC	8417377	The Coca-Cola Company	Transferred
Rothschild Patent Imaging LLC	8437797	3D Robotics, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	ADT, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	ArcSoft, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	AsusTek Computer Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Autel Robotics USA LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Badoo Software Ltd.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Badoo Trading Limited	Settled/Voluntarily Dismissed

Rothschild Patent Imaging LLC	8437797	D-Link Systems, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Edimax Computer Company	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	FLIR Lorex, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Foursquare Labs, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Grindr LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Hobbico, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Honeywell International, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Horizon Hobby, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	JK Imaging Ltd.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Line Euro-Americas Corp.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Logitech Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Lorex By FLIR f/k/a Lorex Technology, Inc.	Substituted
Rothschild Patent Imaging LLC	8437797	LT Security Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	MeetMe, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Netgear, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Parrot, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Photobucket.com, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Pinterest, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	PLR Brand Services, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	PLR Ecommerce, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	PLR IP Holdings, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Pushbullet, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Rakuten USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Ricoh Imaging Americas Corporation	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Skout, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Slomin's, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Swann Communications USA Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Swann Communications USA Inc.	Transferred
Rothschild Patent Imaging LLC	8437797	TangoMe, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	The Firelands Group, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Trendnet, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Tumblr, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	United Technologies Corporation	Substituted
Rothschild Patent Imaging LLC	8437797	United Technologies Fire & Security Americas Corporation	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Vivint, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Vivotek USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	YI Technologies, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8437797	Yuneec USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	Apple Inc.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	Apple Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	Google LLC f/k/a Google Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	HTC America, Inc.	
Rothschild Storage Retrieval Innovations, LLC	8437797	HTC America, Inc.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	HTC Corporation	
Rothschild Storage Retrieval Innovations, LLC	8437797	HTC Corporation	Transferred

Rothschild Storage Retrieval Innovations, LLC	8437797	LG Electronics, Inc.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	LG Electronics, Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	LG Electronics MobileComm USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	LG Electronics MobileComm USA, Inc.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	LG Electronics USA, Inc.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	LG Electronics USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	Microsoft Mobile Inc. f/k/a Nokia, Inc.	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	Motorola Mobility LLC	Settled/Voluntarily Dismissed
Rothschild Storage Retrieval Innovations, LLC	8437797	Nokia Corp.	
Rothschild Storage Retrieval Innovations, LLC	8437797	Samsung Electronics America, Inc.	
Rothschild Storage Retrieval Innovations, LLC	8437797	Samsung Electronics America, Inc.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	Samsung Electronics Co., Ltd.	
Rothschild Storage Retrieval Innovations, LLC	8437797	Samsung Electronics Co., Ltd.	Transferred
Rothschild Storage Retrieval Innovations, LLC	8437797	Sony Mobile Communications (USA), Inc. n/k/a Sony Electronics Inc.	
Rothschild Storage Retrieval Innovations, LLC	8437797	Sony Mobile Communications (USA), Inc. n/k/a Sony Electronics Inc.	Transferred
Rothschild Patent Imaging LLC	8594722	ADT, LLC	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	ArcSoft, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	D-Link Systems, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Edimax Computer Company	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	FLIR Lorex, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Honeywell International, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Logitech Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Lorex By FLIR f/k/a Lorex Technology, Inc.	Substituted
Rothschild Patent Imaging LLC	8594722	LT Security Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Netgear, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Slomin's, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Swann Communications USA Inc.	Transferred
Rothschild Patent Imaging LLC	8594722	Swann Communications USA Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Trendnet, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Vivint, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	Vivotek USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Patent Imaging LLC	8594722	YI Technologies, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Actsoft, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	AGCO Corporation	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Alohar Mobile Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	AT&T Mobility LLC	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Blue Tree Systems, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	CalAmp Corp.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Cellco Partnership d/b/a Verizon Wireless	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	CNH Industrial America LLC	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Deere & Company	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Discrete Wireless, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Fleetcor Technologies, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Fleetmatics USA, LLC	

Rothschild Location Technologies LLC	8606503	Geoforce, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Geotab USA, Inc.	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Global Tracking Communications, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Glympse Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	GoFleet Corporation	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	GPS Insight, LLC	
Rothschild Location Technologies LLC	8606503	Hyundai Motor America	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Iler Group, Inc.	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Imarda USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	InTouch GPS, LLC	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Jaguar Land Rover North America, LLC	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Leica Geosystems Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Life360, Inc.	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Limo Anywhere, LLC	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Lyft, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Marathon Data Operating Co., LLC	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Meitrack America Corporation	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Mix Telematics North America, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Navman Wireless North America, Ltd.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Quartix, Inc.	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Raven Industries, Inc. d/b/a Raven Applied Technology	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Redtail Telematics Corporation	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Roadnet Technologies, Inc.	
Rothschild Location Technologies LLC	8606503	Skypatrol, LLC	Patent Challenger Won
Rothschild Location Technologies LLC	8606503	Smart Fleet LLC	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Spireon, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Sprint Spectrum LP	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Telenav, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Teletrac Inc.	
Rothschild Location Technologies LLC	8606503	Telogis, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	T-Mobile USA, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Trimble Navigation Limited	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	Uber Technologies, Inc.	Settled/Voluntarily Dismissed
Rothschild Location Technologies LLC	8606503	United States Cellular Corporation	Settled/Voluntarily Dismissed

Exhibit B

Lim#	Claim Language	Specification
Pre	1. A locational image verification device for verifying an assignment of a user comprising:	
1(a)	a user verification module for verifying an identity of a user of the device, wherein upon verification, the user verification module enables operation of the device and provides an assignment to the user;	<p>“The device 100 will also include a user verification module . . . [such as a] finger print reader, . . . [for example] the BioTouch™ fingerprint reader commercially available from Identix Incorporated of Minnetonka, Minn.” 5:38–42.</p>
1(b)	a capture module for capturing an image relating to the assignment and creating a digital image file, wherein the user verification module verifies the identity of the user of the device at a time of the image capture;	 <p>FIG. 3A and FIG. 1B are schematic diagrams of a device 100. FIG. 3A shows a front view of the device with an antenna (ANT) at the top, a display screen (228), a keypad (224), and a camera (206). FIG. 1B shows a top view of the device with a display screen (108), a camera (104), and various ports and sensors (110, 112, 114, 124, 128).</p>
1(c)	a locational information module for determining a location of the device when capturing the image;	<p>“The locational information module 134 may include a receiver and antenna employing conventional locational information processing technology such as Global Positioning Satellite (GPS) Technology . . . or any other available locational technology . . .” 5:54–63.</p>

Lim#	Claim Language	Specification
1(d)	a date and time module for determining a date and time of the image capture;	“The date and time module 136 will use standard computer chip processing technology widely in use, or alternatively, input from locational information module 134 , e.g., a GPS receiver, to supply the date and time of the image capture.” 6:5-9
1(f)	a processing module for associating the assignment, the user identity, location information and the time and date to the digital image file; and	<p>“Using standard computer programming and processing, this database would then locate the stored digital image and associated files/information and also process the users request(s) regarding the digital image.” 7:46-49.</p> <p>“The device will contain a computer processing module 120, e.g., a microprocessor.” 3:51-52.</p>
1(g)	an encryption module for encrypting the digital image file and associated information upon image capture.	“The device 100 will also include an encryption module 140 . The encryption module 140 will use conventional code encryption algorithms currently in use or that will be in use in the future such as DES, Triple DES, Blowfish, RSA, MD5, etc.” 6:3135.

Exhibit C

REDACTED IN IT ENTIRETY

Exhibit D

REDACTED IN IT ENTIRETY

Exhibit E

Trials@uspto.gov
571-272-7822

Paper No. 7
Entered: August 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITEK SYSTEMS, INC.,
Petitioner,

v.

ROTHSCHILD MOBILE IMAGING INNOVATIONS, LLC,
Patent Owner.

Case IPR2015-00624
Patent 7,456,872 B2

Before JAMESON LEE, DAVID C. McKONE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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I. INTRODUCTION

A. Background

Mitek Systems, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute *inter partes* review of claims 1–39 of U.S. Patent No. 7,456,872 B2 (Ex. 1001, “the ’872 patent”). Rothschild Mobile Imaging Innovations, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Upon consideration of the Petition and Preliminary Response, we are persuaded, under 35 U.S.C. § 314(a), that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of claims 27, 28, 38, and 39 of the ’872 patent, but not of claims 1–26 or 29–37. Accordingly, we institute an *inter partes* review only of claims 27, 28, 38, and 39 of the ’872 patent.

B. Related Matters

The ’872 patent has been asserted in several lawsuits in the United States District Court for the District of Delaware. Pet. 1–2; Paper 4, 2.

C. References Relied Upon

Petitioner relies on the following references (Pet. 3):

Ex. 1003	Davis et al.	US 2002/0001395 A1	Jan. 3, 2002
	(hereinafter “Davis”)		
Ex. 1004	Steinberg et al.	US 6,433,818 B1	Aug. 13, 2002
	(hereinafter “Steinberg”)		
Ex. 1005	Steinberg et al.	US 6,750,902 B1	June 15, 2004
	(hereinafter “Steinberg ’902”)		

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Ex. 1006 Terp et al. WO 01/31546 A2 May 3, 2001
(hereinafter “Terp”)

Ex. 1007 Fukunaga et al. US 7,502,133 B2 Mar. 10, 2009
(hereinafter “Fukunaga”)

Ex. 1008 Knowles US 7,173,651 B1 Feb. 6, 2007
(hereinafter “Knowles”)

Ex. 1009 Dodge et al. US 7,266,544 B1 Sept. 4, 2007
(hereinafter “Dodge”)

Petitioner also relies on the Declaration of Dr. Irfan Essa (Ex. 1012, “Essa Decl.”).

D. The Asserted Grounds

Petitioner contends that the challenged claims are unpatentable based on the following asserted grounds (Pet. 3):

Reference(s)	Basis	Claim(s) Challenged
Davis and Steinberg	§ 103(a)	1–6, 9–12, 16, 18, 21–24, 27, 28, 30, 31, 34–36, 38, 39
Davis, Steinberg, and Steinberg ’902	§ 103(a)	7, 13, 25, 26, 29
Davis, Steinberg, and Terp	§ 103(a)	14
Davis, Steinberg, and Fukunaga	§ 103(a)	15, 19, 20, 32
Davis, Steinberg, and Knowles	§ 103(a)	8, 17, 33
Davis, Steinberg, and Dodge	§ 103(a)	37

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II. ANALYSIS

A. The '872 Patent

The '872 patent describes digital imaging devices and methods for embedding and retrieving of information in digital images. Ex. 1001, Abstract.

Figures 1A and 1B of the '872 patent are reproduced below:

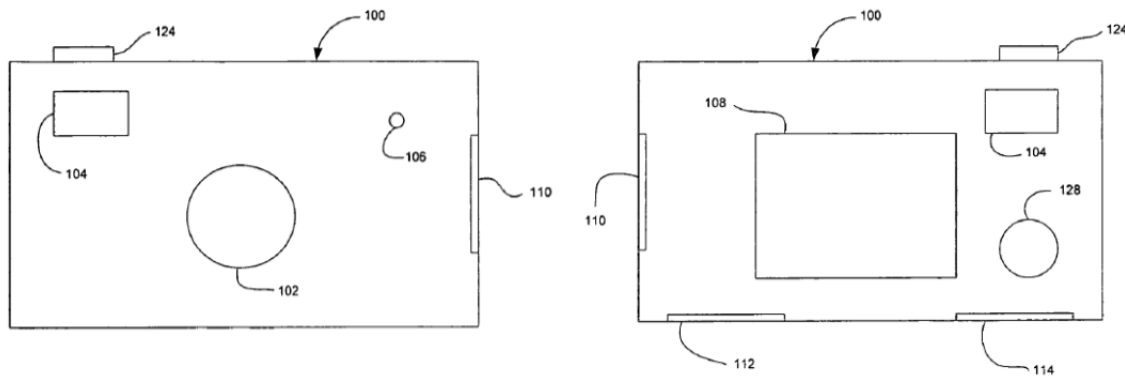


FIG. 1A

FIG. 1B

Figures 1A and 1B are front and back views, respectively, of a device for capturing digital images and embedding information in the captured images. *Id.* at 2:48–51.

As shown in Figure 1A, the front side of device 100 includes lens 102 for capturing an image and microphone 106 for capturing audio information. *Id.* at 3:31–37. As shown in Figure 1B, the rear side of device 100 includes display module 108 (e.g., a touch screen display) for displaying captured images, storage module 110 (e.g., a RAM or removable memory stick) for storing captured images, transmission module 112 (e.g., Bluetooth™, Wi-fi, or parallel or serial cables) for transmitting digital images to another device, and scanning module 114 for scanning and inputting information to be

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associated with an image and for reading information from printed images.

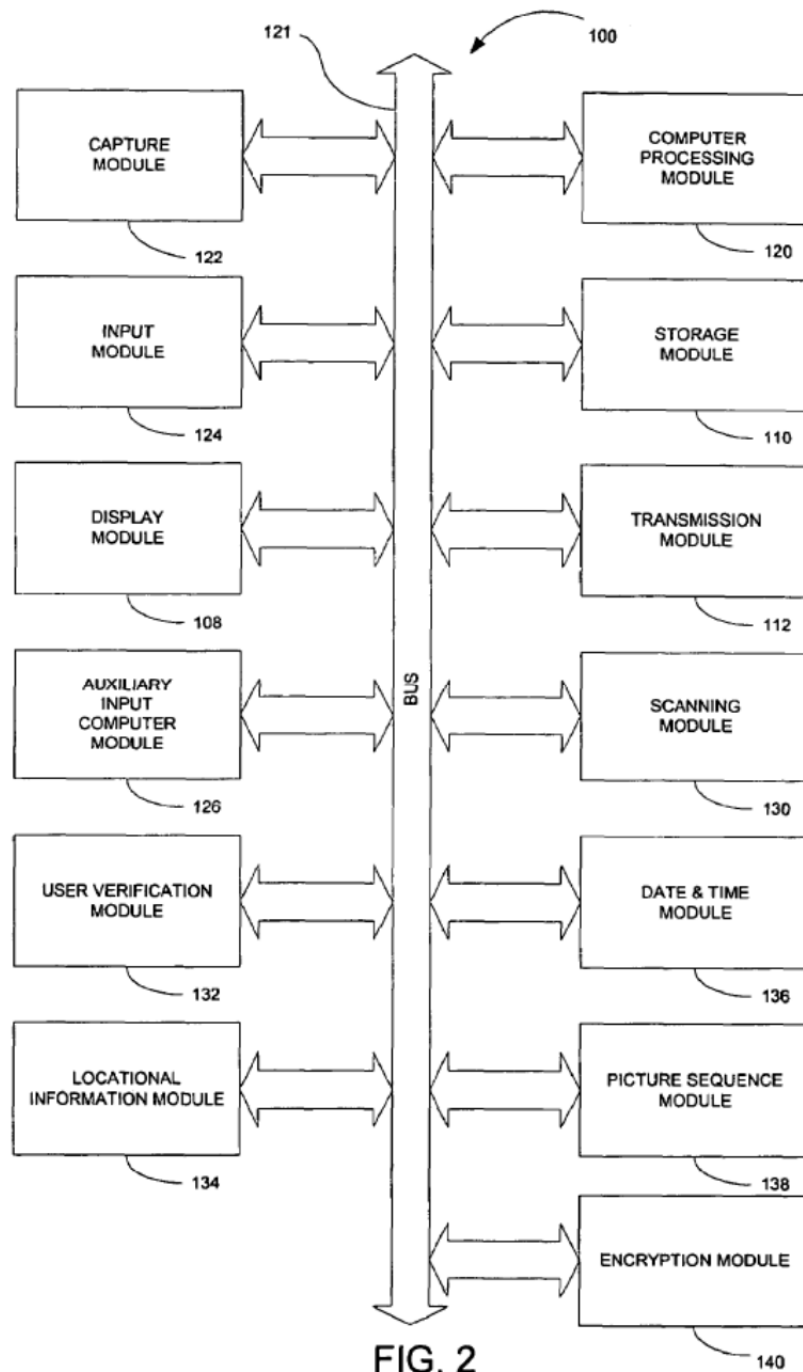
Id. at 3:38–49, 4:29–34, 6:46–58.

In the specific embodiments to which the claims of the '872 patent are directed, the devices (termed “locational image verification devices,” or “LIVDs”) and methods verify or determine user identity; provide to, or receive for, the user an “assignment”; determine the location of the device at the time of image capture; determine the time and date of image capture; associate the assignment, user identity, location, and time and date information with the image; and encrypt the image and associated information. *See, e.g.*, claims 1, 27.

The '872 patent describes the functions of the device in terms of modules, depicted in Figure 2.

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Figure 2 of the '872 patent is reproduced below:



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Figure 2 is a block diagram of the modules of a device for capturing digital images and embedding information in the captured images. *Id.* at 2:52–54.

Display module 108, storage module 110, and transmission module 112 correspond to those depicted in Figures 1A and 1B, above. Capture module 122 works in conjunction with lens 102 to create a digital image, which is stored in storage module 110. *Id.* at 4:13–29. User input module 124 receives text input, for example from a standard keyboard or a touch screen that overlays display module 108. *Id.* at 4:55–62. Auxiliary input module 126 collects data from other devices, such as user verification module 132, locational information module 134, date and time module 136, picture sequencing module 138, and various other input processors providing additional information. *Id.* at 6:13–24. Encryption module 140 encrypts the data information that comes into user input module 124, auxiliary input module 126, and optionally, the digital image file. *Id.* at 6:31–37.

The '872 patent further describes the functions of the LIVDs with reference to Figure 8.

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Figure 8 of the '872 patent is reproduced below.

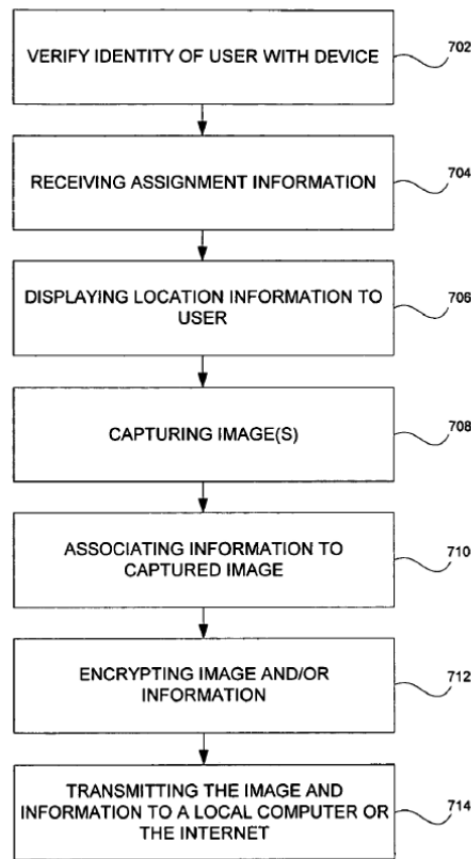


FIG. 8

Figure 8 is a flowchart illustrating a method for verifying activities or assignments of a user employing LIVD 100. *Id.* at 3:6–7, 13:45–14:67.

As shown in Figure 8, the user initializes device 100 by registering his identity with user verification module 132 (step 702). *Id.* at 13:49–52. The user then uses transmission module 112 to receive information (e.g., over the Internet) from the user's office or supervisor as to specific geographic assignments that the user has been given (step 704). *Id.* at 13:58–62. Alternatively, the user may use user input module 124 to input the various

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locations of his/her assignment. *Id.* at 13:66–14:1. The information is maintained in device 100 in standard database form in storage module 110. *Id.* at 14:1–3. The user may be routed to his assignments by means of location information module 134 (step 706), which receives information as to specific assignments from storage module 110. *Id.* at 14:14–17. When the user arrives at his specific assignment, he may use device 100 to verify and capture information (step 708). *Id.* at 14:21–23. “Optionally, the user will be asked to use the user verification module 132 to re-verify his or her identity at the time of image capture.” *Id.* at 14:30–32. Digital images and audio streams captured by LIVD 100 are written to storage module 110 with additional information provided by auxiliary input module 126, which provides information from, *inter alia*, locational information module 134, date and time module 136, and user verification module 132, all of which information is stored as a file associated with the digital image file or written as an additional part of the digital image file (step 710). *Id.* at 14:39–49. In a preferred embodiment, all of the information captured by capture module 122, including the associated information from auxiliary input module 126, user input module 124, and user verification module 132, is immediately encrypted by encryption module 140 (step 712). *Id.* at 14:50–55. The user may then use transmission module 11 to transfer the information to his office, supervisor, or any other party (step 714). *Id.* at 14:65–67.

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Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. *A locational image verification device for verifying an assignment of a user comprising:*
 - a user verification module for verifying an identity of a user of the device, wherein upon verification, the user verification module enables operation of the device and provides an assignment to the user;*
 - a capture module for capturing an image relating to the assignment and creating a digital image file, wherein the user verification module verifies the identity of the user of the device at a time of the image capture;
 - a locational information module for determining a location of the device when capturing the image;
 - a date and time module for determining a date and time of the image capture;
 - a processing module for associating the assignment, the user identity, location information and the time and date to the digital image file; and
 - an encryption module for encrypting the digital image file and associated information upon image capture.

Ex. 1001, 16:56–17:7 (emphasis added).

B. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, at *7–*8 (Fed. Cir. July 8, 2015). Only those terms that are in controversy need to be construed, and then only to the

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extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Claims are not interpreted in a vacuum but are a part of and read in light of the specification. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987); *United States v. Adams*, 383 U.S. 39, 49 (1966). Indeed, although it is improper to read a limitation from the specification into the claims, the claims still must be read in view of the specification of which they are a part. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1347 (Fed. Cir. 2004).

1. “user verification module”

Petitioner asks us to construe the term “user verification module,” as recited in claim 1 of the ’872 patent (see Pet. 7–8). Neither Petitioner nor Patent Owner proposes any specific construction, however, and we conclude that it is not necessary for our determination of whether to institute *inter partes* review to construe expressly the term “user verification module.”

The Specification of the ’872 patent provides examples of “user verification modules” (*see, e.g.*, Ex. 1001, 5:29–51), but does not define or explicitly limit the term. Nonetheless, the plain language of claim 1 explicitly recites that the user verification module “provides an assignment to the user” upon verification of the identity of the user. Ex. 1001, 16:58–

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61. The meaning of that language does not turn on the construction of the term “user verification module,” and we, accordingly, do not construe the term.

2. “assignment”

Claim 1 of the ’872 patent is directed to “[a] locational image verification device for verifying an *assignment* of a user” that comprises, *inter alia*, “a user verification module [that] . . . upon verification, . . . provides an *assignment* to the user”; “a capture module for capturing an image relating to the *assignment* and creating a digital image file . . .”; and “a processing module for associating the *assignment* . . . to the digital image file” Ex. 1001, 16:56–17:7. Similarly, claim 27 of the ’872 patent is directed to “[a] method for verifying an *assignment* of a user, the method comprising the steps of: . . . upon verification, receiving *assignment* information for the user; capturing an image with an imaging device relating to the *assignment* and creating a digital image file; . . . [and] associating the *assignment* information . . . to the digital image file” *Id.* at 18:25–40. The term “assignment” also appears in dependent claims 7 (reciting “a location of the assignment”), 29 (“a location of the assignment”), 30 (“prompting the user for information regarding at least one assignment”), and 37 (“verifying at least one task of the assignment information has been completed”). *Id.* at 17:22–24, 18:44:47, 18:48–50, 19:6–8. Patent Owner seeks to distinguish an “assignment” from a “session,” as the latter term is used in Davis (Ex. 1003). Prelim. Resp. 1, 3–6, 8–14. Petitioner does not propose a construction for “assignment.”

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Although no special definition is provided for “assignment” in the ’872 patent, the term is used in several instances in the Specification. The Specification states, for example:

The user will use the transmission module 112 of the device 100 to receive information through the Global Computer Network from the user’s office or supervisor as to the *specific geographic assignments* that the user has been given (step 704). In a preferred embodiment, this information will be transferred from the user’s office or supervisor from a standard relational database that will contain *data on the specific locations that the user is expected to visit along with tasks associated with each location*. Alternatively, the user may use the user input module 124 to input the various *locations of his/her assignment*.

Ex. 1001, 13:58–14:1.

The Specification also states:

The user may be routed to his *assignments* by means of the locational informational module 134 (step 706). This module will receive the information as to specific assignments from the storage module 110, and then display directions on routing with the display module 108. Thus, the user of the LIVD 100 will receive *geographic directions to his specific assignments*.

When the user *arrives at his specific assignment*, he may use the device 100 to verify and capture information (step 708).

Ex. 1001, 14:14–23.

Still further, the Specification states:

Record 630 of table 628 will include all the information relevant for *verifying at least one assignment or at least one task of an assignment assigned to the user*. For example, record 630 will include an identifier field 632 which will also be used as a key for linking the tables, a location of image capture field 634, a date of image capture field 636, a time of image capture field 638, a user verification field 640, a picture sequence field

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642 and an *assignment completed field* 644. Determining whether an assignment is completed can be accomplished either by the user indicating so via the input module or via the computer processing module by comparing user responses to prompted tasks.

Ex. 1001, 15:14–26.

Patent Owner asserts that the broadest reasonable interpretation of “assignment” is “a task.” Prelim. Resp. 10. According to Patent Owner, “[t]he broadest reasonable interpretation of the term ‘assignment’ . . . is based on its plain and ordinary meaning which is ‘a specified task or amount of work . . . or undertaken as if [given] by authority’” (*id.* 9–10 (quoting MERRIAM-WEBSTER ONLINE DICTIONARY, 2015, <http://www.merriam-webster.com/dictionary/assignment> (modifications by Patent Owner))), “[t]he specification does not explicitly limit the construction of ‘assignment’ in view of its plain and ordinary meaning” (*id.*), and “the prosecution history supports that ‘task’ is a proper construction of the claim term ‘assignment’” (*id.*). “Thus,” according to Patent Owner, “based on the plain and ordinary meaning, the specification, and the prosecution history, the broadest reasonable interpretation of the claim term ‘assignment’ is a task.” *Id.* at 11.

Although Patent Owner’s proposed construction takes into account one possible ordinary meaning of “assignment,” it is deficient because it does not capture the “geographic location” aspect that is vital to the usage of “assignment” in the Specification. In this regard, another definition of “assignment” in the same dictionary, namely, “a position, post, or office to which one is assigned” (*see* MERRIAM-WEBSTER ONLINE DICTIONARY, *supra*), is more naturally aligned with the references in the ’872 patent to,

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for example, “geographic assignments,” “locations of . . . assignment,” “geographic directions to . . . specific assignments,” and “arriv[al] at [an] assignment” (*see, e.g.*, Ex. 1001, 13:61, 13:67–14:1, 14:19–20, 14:21).

Two of the usage examples provided by Patent Owner’s dictionary are illustrative of the distinction. One example, “[t]he reporter’s *assignment* is to interview the candidate,” is consistent with an assignment simply being a task. That example, however, lacks any location aspect and is, accordingly, much broader than the usage of “assignment” in the Specification. In contrast, another example, “[t]he reporter is here *on assignment*,” implies a geographic location and, therefore, more closely aligns with the Specification’s usage of the term “assignment.”

Patent Owner contends “the [S]pecification . . . does not limit the term ‘assignment’ to only geographic locations . . . [but] clarifies that the assignment includes a task.” Prelim. Resp. 10. The Specification, however, makes clear that an assignment includes at least a geographic location to which a user is assigned to perform a task, such as to capture information. Accordingly, a construction without that geographic location aspect is unreasonably broad in light of the Specification.

For purposes of this Decision, therefore, in light of the ordinary meaning of “assignment,” as evidenced by a dictionary definition, as well as the description in the Specification, we construe “assignment” to mean “a location to which a user is assigned to perform a task.”

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C. Proposed Ground 1: Obviousness of Claims 1–6, 9–12, 16, 18, 21–24, 27, 28, 30, 31, 34–36, 38, and 39 over Davis and Steinberg

Petitioner contends claims 1–6, 9–12, 16, 18, 21–24, 27, 28, 30, 31, 34–36, 38, 39 would have been obvious over the combined teachings of Davis and Steinberg. Pet. 10–40.

1. Claims 1–6, 9–12, 16, 18, and 21–24

Petitioner contends Davis discloses each element required by independent claim 1, except for explicit disclosure of “a user verification module for verifying an identity of a user of the device, wherein upon verification, the user verification module enables operation of the device and provides an assignment to the user” and that “the user verification module verifies the identity of the user of the device at a time of the image capture.” Pet. 10–21. Petitioner relies on Steinberg to account for those features. *Id.* at 11–17.

According to Petitioner:

With respect to all of the claimed modules in the claims of the '872 patent, including the “user verification module,” *Davis* discloses that the functions of its digital camera may be implemented using one or more components (which alone or collectively form a module depending on their disclosed contribution to the disclosed functions), such as application programs executed on a processing unit such as a microprocessor or DSP. *See, e.g.*, Ex. 1003, ¶¶ [0035]–[0037], [0082]–[0083]. Thus, all of the functions of *Davis*’s camera are performed using respective modules. For example, one function of *Davis*’s digital camera that would thus be implemented using an application program executed by a

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processing unit obtains the identity of a user of the camera. *See id.*, ¶¶ [0060]–[0061], [0108]; *see also* Ex. 1012, ¶¶ 18, 33.

....

Davis discloses a “locational image verification device for verifying an assignment of a user,” such as a digital camera that may be used by a photographer whose supervisor provides operating parameters that define a session (e.g., an assignment). *See* Ex. 1003, ¶¶ [0032]–[0043], [0065]–[0066], Fig. 1. As one example, a session (e.g., an assignment) for capturing an image may be defined “for selected GPS locations within a defined range,” and the user may be disallowed from capturing images when the camera travels outside a particular geographic location specified in the session parameters. *See id.*, ¶¶ [0068]–[0069]. Similarly, the session parameters can also selectively allow certain actions within a given area. *Id.*, ¶ [0069]. *See also* citations and analysis below for claim elements 1(b)–(g). Ex. 1012, ¶ 30.

Id. at 10–11.

Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that independent claim 1 or claims 2–6, 9–12, 16, 18, and 21–24 dependent therefrom would have been obvious over *Davis* and *Steinberg*. Claim 1 does not require merely that an assignment be “provided,” but specifically requires the assignment to be provided “to the user” by a user verification module that verifies an identity of a user of the device, enables operation of the device, and provides an assignment to the user. Petitioner has provided no persuasive evidence that the combination of *Davis* and *Steinberg* discloses that an assignment is provided to the user by such a module. Indeed, although cited portions of *Davis* indicate, for example, that *Davis*’s camera “receives operating parameters for [a] session,” “makes all settings to comply with the instructions specified in the

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operating parameters,” and “operates under the control of parameters that govern th[e] session” (Ex. 1003, ¶¶ 66, 67), Davis is silent as to whether operating parameters or any other session information is ever provided “to the user,” much less by a user verification module that verifies identity of the user. Moreover, Petitioner does not contend that Steinberg cures this deficiency.

For the foregoing reasons, Petitioner has not shown a reasonable likelihood that it would prevail in establishing that any of claims 1–6, 9–12, 16, 18, and 21–24 would have been obvious over Davis and Steinberg.

2. Claims 27, 28, 38, and 39

Claim 27 is an independent method claim in which most of the steps essentially track the functions of the modules recited in claim 1. Importantly, however, claim 27 neither ties those functions to specific modules nor recites that an assignment must be provided “to” a user, as in claim 1. In particular, claim 27 does not include the limitation recited in claim 1 of “a user verification module for verifying an identity of a user of the device [that both] enables operation of [a] device and provides an assignment to the user,” which is lacking from the combined teachings of Davis and Steinberg. Instead, claim 27 recites the steps of “verifying a user of the device to enable use of the device” and “upon verification, receiving assignment information for the user,” without requiring those steps to be performed by the same module or modules.

Petitioner contends that claim 27 would have been obvious for the same reasons given for claim 1. Pet. 32–35. Based on our consideration of

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the evidence in the Petition, we are persuaded in light of the differences between claims 1 and 27 that Petitioner has demonstrated a reasonable likelihood that it would show that claim 27 would have been obvious over Davis and Steinberg.

Patent Owner does not argue independent claim 27 separately, but relies on an argument made with respect to claim 1 that “neither Davis nor Steinberg discloses, *inter alia*, the claim term ‘assignment’ in claim 1 and the Petitioner has not articulated any reasoning that a person of ordinary skill in the art would not [sic] be able to infer the claim term ‘assignment’ based on the teachings of the asserted prior art.” Prelim. Resp. 4.

Patent Owner’s argument is not persuasive. As cited by Petitioner, Davis discloses a “session mode” in which a camera operates under the control of parameters that may be established from an external device. Ex. 1003, ¶ 66–69. Davis discloses that the “session” may be in effect, for example, for a specified period of time, for a selected number of images, or for selected GPS locations within a defined range. *Id.* at ¶ 68. The camera can be programmed to operate according to the parameters that govern the session and may, for example, disallow the user from capturing images when the camera travels outside a particular location specified in the session parameters and monitored by a GPS unit within the device. *Id.* at ¶ 69.

Citing one dictionary definition of “session,” Patent Owner asserts that “a ‘session’ is construed as a period of time to perform an activity” and that “Davis discloses this plain and ordinary meaning of ‘session’ by stating the ‘the session may be in effect for a specified period of time.’” Prelim. Resp. 13 (citing MERRIAM-WEBSTER ONLINE DICTIONARY, 2015,

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<http://www.merriam-webster.com/dictionary/session>; Ex. 1003, ¶ 67). As Patent Owner acknowledges, however, “Davis continues by stating that the session may be ‘for selected number of images and for selected GPS locations within a defined range.’” *Id.* (citing Ex. 1003, ¶ 67). It is clear from Davis’s disclosure of the session being in effect “for selected GPS locations within a defined range,” for example, that Davis’s usage of “session” is not limited to “a period of time to perform an activity,” as Patent Owner suggests, but that the session operating parameters explicitly define embodiments within the scope of the claim term “assignment” as construed in Section II.B.2. above as “a location to which a user is assigned to perform a task.”

Petitioner’s evidence (Pet. 10–21, 32–35) is persuasive that the combination of Davis and Steinberg discloses all of the steps of claim 27. With respect specifically to the step of “receiving assignment information for the user,” Davis discloses receipt of operating parameters for a session by Davis’s camera, setting, for example, the place for the session. Ex. 1003, ¶ 67. For the reasons set forth in the discussion of Patent Owner’s arguments above, such operating parameters are “assignment information” within the broadest reasonable interpretation of that term. Moreover, because Davis discloses that the camera operating according to the session parameters may, for example, disallow the user from capturing images when the camera travels outside a particular location specified in the session parameters (Ex. 1003, ¶ 69), Davis discloses that the assignment information is received “for the user.” In light of such disclosures in Davis and our consideration of the evidence cited in the Petition with respect to the

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remaining elements of claim 27, we are persuaded sufficiently that Petitioner has shown a reasonable likelihood that it would prevail in establishing the unpatentability of claim 27 as obvious over Davis and Steinberg.

Each of dependent claims 28, 38, and 39 depends directly from claim 27. Each recites additional features that Petitioner contends are taught by Davis and Steinberg. Pet. 35, 40. Patent Owner does not argue claims 28, 38, or 39 separately. Based on our consideration of the evidence in the Petition, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would show that claims 28, 38, and 39 would have been obvious over Davis and Steinberg.

3. Claims 30, 31, and 34–36

Claims 30, 31, 34, 35, and 36 depend directly or indirectly from claim 29. Petitioner contends that these claims would have been obvious over Davis and Steinberg. As discussed in section II.D. below, Petitioner does not allege that claim 29 is rendered obvious by Davis and Steinberg but instead relies on the three-way combination of Davis, Steinberg, and Steinberg '902 (*id.* at 46). For the reasons stated in section II.D. below, Petitioner's argument that claim 29 would have been obvious over Davis, Steinberg, and Steinberg '902 is unpersuasive. Therefore, Petitioner's contentions that claims 30, 31, and 34–36 would have been obvious over Davis and Steinberg alone (Pet. 35–40) are also unpersuasive.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of claims 30, 31, and 34–36 as obvious over Davis and Steinberg.

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D. Proposed Ground 2: Obviousness of Claims 7, 13, 25, 26, and 29 over Davis, Steinberg, and Steinberg '902

Claims 7, 13, 25, and 26 depend directly or indirectly from claim 1. Each recites additional features that Petitioner contends are taught by Steinberg '902. Pet. 41–46. Petitioner, however, does not allege that Steinberg '902 discloses either “a user verification module [that] . . . provides an assignment to [a] user” or “receiving geographic directions from at least one location to a location of [an] assignment and displaying the directions to [a] user,” which features are lacking from Davis and Steinberg. Therefore, Petitioner’s reliance on Steinberg '902 does not cure the deficiencies discussed above with regard to Davis and Steinberg as applied to the elements of claim 1.

Claim 29 depends from claim 27 and recites, *inter alia*, the steps of “receiving geographic directions from at least one location to a location of the assignment and displaying the directions to the user.” Petitioner concedes “Davis and Steinberg do not explicitly disclose that ‘the display module displays geographic directions to the user from at least one location to a location of the assignment’” (Pet. 41) and relies on the three-way combination of Davis, Steinberg, and Steinberg '902 as rendering obvious the subject matter of claim 29 (Id. at 46). According to Petitioner:

Steinberg '902 discloses a digital camera that can receive data from an external source. Ex. 1005, 12:12–15; Ex. 1012, ¶ 87. For example, similarly to the “selected GPS locations” sent to the camera of *Davis*, *Steinberg '902* discloses that “[o]perational data can be sent to inform the user when and where to take a picture.” Ex. 1005, 12:18–19. Moreover, a

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“map showing where to take a picture can be sent” to the camera, “which can be displayed by the user on a camera visual display.” *Id.*, 12:19–21. The map in *Steinberg* ’902 would thus provide directions for [sic] at least one location (e.g., a location on the map other than a location at which a picture should be taken) to a location at which a picture should be taken. See Ex. 1012, ¶ 87.

Pet. 41–42.

Petitioner’s arguments concerning claim 29 are not persuasive. Although, as Petitioner explains (*id.* at 41), *Steinberg* ’902 discloses display of “a map showing where to take a picture” (*id.* at 12:19–21), the cited portions of *Steinberg* ’902 provide no support for Petitioner’s conclusion that “[t]he map in *Steinberg* ’902 would thus provide directions [from] at least one location . . . to a location at which a picture should be taken” (Pet. 41–42). Simply put, the display of a map of a location is not the same as a display of “geographic directions” to that location.

Paragraph 87 of Dr. Essa’s declaration, which Petitioner cites in support of its conclusion, simply provides a near-verbatim recitation of the above-quoted portion of the Petition and cites the same portions of *Steinberg* ’902.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of claims 7, 13, 25, 26, and 29 as obvious over Davis, *Steinberg*, and *Steinberg* ’902.

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E. Proposed Grounds 3–6: Obviousness of Claims 8, 14, 15, 17, 19, 20, 32, 33, and 37 over Davis and Steinberg in combination with Terp, Fukunaga, Knowles, or Dodge

Claims 8, 14, 15, 17, 19, and 20 depend directly or indirectly from claim 1. Claims 32, 33, and 37 depend directly or indirectly from claim 30. Each recites additional features that Petitioner contends are taught by Terp, Fukunaga, Knowles, or Dodge. Pet. 46–60. Petitioner, however, does not allege that Terp, Fukunaga, Knowles, or Dodge discloses either “a user verification module [that] . . . provides an assignment to [a] user” or “receiving geographic directions from at least one location to a location of [an] assignment and displaying the directions to [a] user,” which features are lacking from Davis and Steinberg. Therefore, Petitioner’s reliance on Terp, Fukunaga, Knowles, and Dodge does not cure the deficiencies discussed above with regard to Davis and Steinberg as applied to the elements of claims 1 and 30.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in establishing the unpatentability of claims 8, 14, 15, 17, 19, 20, 32, 33, and 37 as obvious over the combination of Davis and Steinberg with Terp, Fukunaga, Knowles, or Dodge.

III.CONCLUSION

Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of each of claims 27, 28, 38, and 39 of the ’872 patent. Petitioner, however, has not established a reasonable likelihood that it would prevail in showing the unpatentability of any of claims 1–26 or

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29–37 of the '872 patent. The Board has not yet made a final determination with respect to the patentability of any claim or the construction of any claim term.

IV. ORDER

For the reasons given, it is

ORDERED that, pursuant to 35 U.S.C. § 314, *inter partes* review is hereby instituted for claims 27, 28, 38, and 39 of the '872 patent under 35 U.S.C. § 103(a) as obvious over Davis and Steinberg;

FURTHER ORDERED that except as specifically enumerated above, no other ground of unpatentability, with respect to any claim, is instituted for trial; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

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